

DAC
\$

ARNOLD & PORTER



July 23, 2003

Holly Logue Prutz
Holly_Prutz@aporter.com202.942.5243
202.942.5999 Fax555 Twelfth Street, NW
Washington, DC 20004-1206Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-145012/10/2003 KKing1 00000002 502387 09816660
01 FC:1460 130.00 DA**Attn: Mail Stop Petition**

Re: U.S. Patent Application No. 09/816,660
Filed: March 26, 2001
Title: **Nucleic Acid Molecules and Other Molecules Associated with
Transcription in Plants**
Applicants: Linda L. LUTFIYYA *et al.*
Atty. Docket No.: 16517.008/15300G

Sir:

The following documents are forwarded herewith for appropriate action by the U.S.
Patent and Trademark Office (USPTO):

1. Petition for Revival of an Unintentionally Abandoned Patent Application under 37 C.F.R. § 1.137(f) and for Express Abandonment under 37 C.F.R. § 1.138(c), including Exhibit A (in duplicate); and
2. Return postcard.

Please stamp the postcard with the filing date of these documents and return it to our courier.

Applicants request that the following fees be charged to Deposit Account No. 50-2387, referencing docket number 16517.008:

<u>\$1,300.00</u>	Petition to revive unintentionally abandoned application; and
<u>\$ 130.00</u>	Petition for Express Abandonment.

OK FOR ABANDONMENT

RECEIVED
USPTO-PG PUBS
DEC 9 - 2003

DEC 9 - 2003

PG PUB DIVISION
INITIALS BDD**RECEIVED**
JUL 24 2003
OFFICE OF PETITIONS

ARNOLD & PORTER

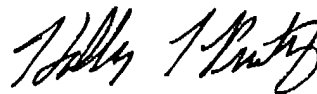
Commissioner for Patents

July 23, 2003

Page 2

Applicants do not believe that any fees other than the \$1,430.00 are due in conjunction with this filing. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. However, if any fees under 37 C.F.R. §§ 1.16 or 1.17 are required in the present application, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter Deposit Account No. 50-2387, referencing matter number 16517.008. A duplicate copy of this letter is enclosed.

Respectfully submitted,



David R. Marsh (Reg. Attorney No. 41,408)

Holly Logue Prutz (Reg. Attorney No. 47,755)

Attachments



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Linda L. LUTFIYYA *et al.*

Appl. No.: 09/816,660

Filed: March 26, 2001

Title: **Nucleic Acid Molecules and Other
Molecules Associated with
Transcription in Plants**

Art Unit: 1646

Examiner: To Be Assigned

Atty. Docket: 38-21(15300)G

**Petition for Revival of an Unintentionally Abandoned
Patent Application Under 37 C.F.R. § 1.137(f) and for
Express Abandonment Under 37 C.F.R. § 1.138(c)**

Attn: Mail Stop Petition
Commissioner for Patents
P.O. Box 1405
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition for: (1) revival of the above-captioned U.S. application under 37 C.F.R. § 1.137(f), for purposes of establishing co-pendency with child applications Serial No. (not yet assigned), filed May 14, 2003, naming Thomas J. La Rosa, Linda L. Lutfiyya, Yihua Zhou, David K. Kovalic, Brad Barbazuk, Ping Li, and Wei Wu as inventors and having Attorney Docket No. 38-21(53333)B (the "First Child Application") and Serial No. (not yet assigned), filed July 2, 2003, naming Thomas J. La Rosa, David K. Kovalic, Yihua Zhou, and Youngwei Cao as inventors and having Attorney Docket No. 38-21(53373)A (the "Second Child Application"); and (2) express abandonment of U.S. Application Serial No. 09/816,660 under 37 C.F.R. § 1.138(c) as of the later of the respective filing dates granted to the First Child Application and the Second Child Application, for purposes of avoiding publication of the above-captioned U.S. application. Authorization to charge the official fees for this Petition is given in the accompanying transmittal letter. A duplicate copy of this Petition is enclosed.

RECEIVED

JUL 24 2003

Linda L. LUTFIYYA *et al.*
Appl. No. 09/816,660
Page 2

On March 26, 2001, the above-captioned U.S. application was filed with a Request for Non-Publication, which contained a certification under 35 U.S.C. § 122(b)(2)(B)(i), including a statement that the invention "has not and will not be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing." (Request attached hereto as Exhibit A). Thereafter it was discovered that one or more foreign applications, which may be related to the invention disclosed in the above-captioned U.S. application, were subsequently filed in another country or under a multilateral agreement that requires publication at eighteen months after filing. One such application was filed on December 17, 2001 (the "Foreign Application").¹

Applicants inadvertently did not notify the Director of the filing of the Foreign Application within 45 days of its filing. Therefore, Applicants believe that the above-captioned U.S. application may be abandoned pursuant to 35 U.S.C. § 122 (b)(2)(B)(iii), because the Foreign Application is directed to one or more nucleic acid or amino acid sequences, or both, that exhibit at least 85% sequence identity over 80% of their length to one or more nucleic acid or amino acid sequences, or both, disclosed in the above-captioned U.S. application.²

In light of the above, Applicants hereby explicitly notify the Office of the filing of the Foreign Application on December 17, 2001, pursuant to 35 U.S.C. § 122 (b)(2)(B)(iii). Applicants assert that any delay of providing such notice to the Office was inadvertent.

Applicants hereby petition for revival of U.S. Application Serial No. 09/816,660 under 37 C.F.R. § 1.137(f), for purposes of establishing co-pendency with the above-referenced child applications. Applicants hereby assert that any and all delay in filing the

¹ Where more than one application was filed in another country or under a multilateral agreement, only the date for the earliest-filed foreign application is recited herein.

² Applicants do not assert that nucleic acid sequences or amino acid sequences that exhibit at least 85% identity over 80% of their length either are or are not an "invention disclosed in the application" within the meaning of 35 U.S.C. § 122.

Linda L. LUTFIYYA *et al.*

Appl. No. 09/816,660

Page 3

required reply, *i.e.*, notification to the Office of the Foreign Application, from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b), was unintentional and respectfully request that the above-captioned U.S. application be revived.

Applicants also hereby petition for express abandonment of U.S. Application Serial No. 09/816,660 under 37 C.F.R. § 1.138(c) as of the later of the respective filing dates granted to the First Child Application and the Second Child Application, for purposes of avoiding publication of the above-captioned U.S. application.

The above-captioned U.S. application contains multiple sequences, only some of which meet the criteria such that those sequences may be considered to be the "invention disclosed" within the meaning of 35 U.S.C. § 122. However, in lieu of submitting a redacted copy of the above-captioned U.S. application, provided for under 35 U.S.C. § 122 (b)(2)(B)(v), Applicants have elected to pursue the present course of action of refiling two applications, one containing those sequences which may be disclosed in the Foreign Application without a request for non-publication, and one application containing sequences which were not disclosed in the Foreign Application with a request for non-publication.

Linda L. LUTFIYYA *et al.*
Appl. No. 09/816,660
Page 4

Should the Commissioner require additional information, he is invited to contact the undersigned at the number provided below. The undersigned is an attorney of record, or an attorney acting in a representative capacity for Applicants by virtue of being named in the transmittal papers accompanying the above-referenced child applications, and therefore has authority to petition for abandonment of the above-captioned U.S. application in favor of the above-referenced child applications pursuant to 37 C.F.R. § 1.138(b), 1.33(b), and 1.34(a).

Respectfully submitted,

Lawrence M. Lavin, Jr.

Lawrence M. Lavin, Jr. (Reg. No. 30,768)
by David R. Marsh (Reg. No. 41,408)

Date: July 23, 2003

MONSANTO COMPANY
800 N. Lindbergh Blvd.
Mailzone N2NB
St. Louis, MO 63167
(314) 694-3602 telephone
(314) 694-1671 facsimile

by
David R. Marsh